



UNITED STATES PATENT AND TRADEMARK OFFICE

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DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, DC 20231  
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MAY 10 2005

Mitchell R. Swartz ScD, MD, EE  
16 Pembroke Road  
Weston, MA 02493

May 9, 2005

In re: Mitchell R. Swartz : Decision on Petition under  
Serial No. 09/748,691 : 37 CFR 1.181  
Filed : December 26, 2000 :

For: Method to Control Reactions Involving Isotopic Fuel Within a Material Using  
Orthogonal Electric-Fields

This decision addresses the following petition filed by applicant:

- The petition filed on November 26, 2003 under 35 USC 181 petitioning the letter mailed on November 18, 2003 citing defects in applicants Appeal Brief filed September 25, 2003.
- The petition filed on February 3, 2004 under 35 USC 181 petitioning the letter mailed on January 22, 2004 citing defects applicants Appeal Brief filed on December 2, 2004.

**RELEVANT HISTORY**

On **May 5, 2003**, applicant filed a Notice of Appeal appealing the final rejection made on January 30, 2003.

On **July 3, 2003**, applicant filed an Appeal Brief.

On **August 29, 2003**, a Notice of Non-Compliance with 37 CFR 1.192(c) was mailed to the applicant. The Notice indicated that the status of the amendments was improper, the summary of the invention was improper, the scope of the issues was improper, the grouping of claims was improper, and the arguments section was incomplete. A detailed discussion of these issues can be found in the Notice. Applicant was given a one-month extendable time period to correct the defects.

On **September 25, 2003** a second Appeal Brief was filed, dated by the applicant as September 17, 2003.

On **November 18, 2003** a letter was mailed to the applicant indicating that the second Appeal Brief remained defective. The letter alleged that the summary of the invention

still included subject matter not found in the specification, the recitation of issues were still improper, and the arguments section remained incomplete. The letter stated "Since the above deficiencies have been listed in the 8/29/03 Office Action, Applicant's failure to correct them is no longer considered inadvertent", additionally the examiner stated "Since the period for reply set forth in the prior Office action has expired, this applicant will become abandoned unless applicant corrects the deficiency and obtains an extension of time under 37 CFR 1.136(a)."

On November 26, 2003, the first petition was filed petitioning the November 18, 2003 letter.

On December 2, 2003, applicant filed "Appellant's Notice To The Board Of False Statements In An Office Communication Dated 11/18/03".

On January 22, 2004, the examiner treated the letter as an attempt to correct the defective Appeal Brief. The examiner mailed a letter indicating that the Appeal Brief remained defective.

On February 3, 2004, applicant petitioned the letter mailed on January 22, 2004.

On February 5, 2004, applicant filed "Appellant's Notice To The Board Of False Statements In An Office Communication Dated 1/22/04".

## DISCUSSION

As a formal matter, applicant was given an extendable one-month period for response on August 29, 2003. Applicant's statutory time period for adequately responding to this letter would have expired on February 29, 2004. A complete and adequate reply would have been to adequately address the defects cited in the August 29, 2003 letter and pay any required extension of time due at the time of response. A review of the file and facts indicated above reveals that applicant response filed on September 25, 2003 was timely. There have been no further Appeal Briefs filed. Therefore, applicant's application will be considered abandoned as of September 30, 2003 unless this decision determines that the examiners action of November 18, 2003 was completely in error.

Additionally, it is recognized that Appellant is a *pro-se* applicant. MPEP 1206 states: "An exception to the requirement that all the items specified in 37 CFR 1.192(c) be included in the brief is made if the application or reexamination proceeding is being prosecuted by the appellant *pro se*, i.e., there is no attorney or agent of record, and the brief was neither prepared nor signed by a registered attorney or agent. The brief of a *pro se* appellant which does not contain all of the items, (1) to (9), specified in 37 CFR 1.192(c) will be accepted as long as it substantially complies with the requirements of items (1), (2), and (8). If the brief of a *pro se* appellant is accepted, it will be presumed that all the claims of a rejected group of claims stand or fall together unless an argument is included in the brief that presents reasons as to why the appellant considers one or

more of the claims in the rejected group to be separately patentable from the other claims in the group.”

There are no issues in this petition with respect to items 1 and 2. For the record, item 8 is outlined below:

*(8) Argument. The contentions of appellant with respect to each of the issues presented for review in paragraph (c)(6) of this section, and the basis therefor, with citations of the authorities, statutes, and parts of the record relied on. Each issue should be treated under a separate heading.*

*(i) For each rejection under 35 U.S.C. 112, first paragraph, the argument shall specify the errors in the rejection and how the first paragraph of 35 U.S.C. 112 is complied with, including, as appropriate, how the specification and drawings, if any, (A) Describe the subject matter defined by each of the rejected claims, (B) Enable any person skilled in the art to make and use the subject matter defined by each of the rejected claims, and (C) Set forth the best mode contemplated by the inventor of carrying out his or her invention.*

*(ii) For each rejection under 35 U.S.C. 112, second paragraph, the argument shall specify the errors in the rejection and how the claims particularly point out and distinctly claim the subject matter which applicant regards as the invention.*

*(iii) For each rejection under 35 U.S.C. 102, the argument shall specify the errors in the rejection and why the rejected claims are patentable under 35 U.S.C. 102, including any specific limitations in the rejected claims which are not described in the prior art relied upon in the rejection.*

*(iv) For each rejection under 35 U.S.C. 103, the argument shall specify the errors in the rejection and, if appropriate, the specific limitations in the rejected claims which are not described in the prior art relied on in the rejection, and shall explain how such limitations render the claimed subject matter unobvious over the prior art. If the rejection is based upon a combination of references, the argument shall explain why the references, taken as a whole, do not suggest the claimed subject matter, and shall include, as may be appropriate, an explanation of why features disclosed in one reference may not properly be combined with features disclosed in another reference. A general argument that all the limitations are not described in a single reference does not satisfy the requirements of this paragraph.*

*(v) For any rejection other than those referred to in paragraphs (c)(8)(i) to (iv) of this section, the argument shall specify the errors in the rejection and the specific limitations in the rejected claims, if appropriate, or other reasons, which cause the rejection to be in error.*

In light of the above, it has been determined that the petition with respect to most of the issue are hereby granted, giving consideration to appellants pro-se status. The exception being the issues with respect to section 8 of this rule.

With respect to letter mailed November 18, 2003, the examiner's position is that the Argument section does not address the new matter rejection under section 9 of the Final Office action. The text of that section in the final rejection is as follows: "Claims 8, 10, 13, 24, 26 and 28 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The new subject matter and reasons why they are such are discussed in section 5 above."

Appellant's addresses this issue at pages 10 and 11 of the petition. Appellant states that the Office is wrong for "at least seven reasons".

"First, Appellant respectfully disputes this because the purported "new matter rejection" was identified and discussed on pages 3 and 4 in said Notice." This argument cannot be addressed as the intent of this statement is unclear.

"Second, Appellant respectfully disputes this because Appellant addressed this matter in the response to the Office in his "Notice of Compliance by Appellant", dated Sep. 17, 2003." In this argument, Appellant refers to pages 68-78 of the Appeal Brief. A review of this part of the Brief, however failed to reveal any argument with respect to these claims or the new matter issue. Additionally, a review of the Brief section with respect to the rejections under 35 USC 112 failed to reveal any argument with respect to this issue.

"Third, Appellant respectfully disputes this because the Office is nonspecific, consistent with confabulation (vide supra, vide infra)" In response, this issue cannot be addressed in that appellant has not provided any facts or evidence to support this conclusion with respect to the new matter issue at hand.

"Fourth, Appellant already made changes because the Office demanded it in the previous first Communication, as discussed above. Appellant took the time and money to make new briefs in triplicate". In response, this argument has no bearing on whether or not Appellant addressed the new matter rejection of issue.

"Fifth, Appellant respectfully disputes this because the Office is nonspecific, consistent with confabulation (vide supra, vide infra)". In response, this issue cannot be addressed in that appellant has not provided any facts or evidence to support this conclusion with respect to the new matter issue at hand.

"Sixth, Appellant respectfully disputes this because NONE of this has been addressed by the Office in said "Notice of Compliance by Appellant", dated Sept. 17, 2003, pages 3 and 4." In response, this argument is confusing because the Sept. 17, 2003 letter was sent by the appellant and not the Office. Therefore the Office would not have addressed this argument in that paper. The Office, however, has raised this issue in response to the Brief of September 17, 2003 (as dated by the applicant).

"Seventh, Appellant notes that this confabulation suggests obstruction of justice under color of law by the Office." In response, this argument is without merit or bases.

In conclusion, the examiner was correct in holding the Appeal Brief received by the Office on September 25, 2003 as non-compliant with 37 CFR 1.192(c)(8).

The Petitions of November 26, 2003 and February 4, 2004 are **DENIED**.

After mailing of this decision, the application will be forwarded to the examiner for disposal of the application.

Any questions or comments with respect to this decision should be forwarded to Michael J. Carone in writing.



Donald T. Hajec, Director  
Technology Center 3600

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